

First, it is respectfully submitted that the claims directed to the pressure sensitive adhesive layer (claims 18 plus) produced from the non-reactive pressure sensitive hot melt adhesive composition of claim 1, are related as combination to sub-combination, inasmuch as the layer claims require all of the elements of the composition claims. M.P.E.P. §806.05(a) defines the combination/sub-combination relationship as a situation where a combination is an organization of which a sub-combination or element is a part. In order to support the Restriction Requirement in such a situation, the M.P.E.P. further holds that the combination must “not require the particulars of the sub-combination as claimed for patentability to show novelty and unobviousness” and the sub-combination must be shown to have utility either by itself or in different combinations. Arguably, the Examiner has attempted to satisfy the second requirement of this test, in the allegation that the alleged “intermediate product”, the adhesive composition, could be used as a raw material for extruded sheeting. The first prong of the test, however, has not been, and cannot be, satisfied. This is because the layer claims require the particulars of the adhesive composition, by their very dependence on the adhesive composition claims.

It should be noted, at this juncture, that it is different to say that the combination “requires the particulars of the sub-combination for patentability”, as here, then to say that the combination and sub-combination are not patentably distinct. In the present situation, the combination requires the particulars of the sub-combination, since it recites all the elements of the adhesive composition therein. Since Applicants, of course, do not allege that the mere combination of any adhesive composition applied to a substrate is novel, it can be seen that it is the particular adhesive composition, recited in claim 1, that is used to provide patentability in the layer claims. However, even if the adhesive composition were known *per se* (it is not admitted herein that this is the case) the layer could possess independent patentability if the adhesive were never disclosed in such a utility.

In any event, it is submitted that the two-way distinctness test required in the M.P.E.P. cannot be established since the combination requires all the elements of the sub-combination as discussed above. M.P.E.P. §806.05(c), under the heading “Sub-Combination Essential to Combination”, details the present situation, and states that a restriction “must not” be made, even though the sub-combination has separate utility. This is clearly the case herein, and it is submitted that the M.P.E.P. mandates withdrawal of the Restriction Requirement on this basis

alone. Moreover, even if the characterization employed in the Restriction Requirement (species/intermediate-final product) were applicable to the present situation, M.P.E.P. §803.01 states as follows:

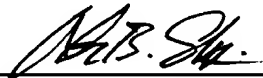
“where plural inventions are capable of viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.”

Thus, it is evident that even if the claims are related as intermediate/final product, the combination/sub-combination requirement must be met as well in order to support the Restriction Requirement. Since it cannot, the Restriction Requirement is improper and should be withdrawn.

It is further noted that added claim 22, also directed to the pressure sensitive adhesive layer, is related to the composition claims in Group I by claim 23, which is in the manner of a linking claim. Claim 23 recites a method for making the adhesive layer of Group II, comprising applying the composition of Group I to the substrate. If the composition of Group I is found allowable, its use is also patentable, see *In re Brouwer*, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996) and *In re Ochiai*, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995) and M.P.E.P. §821.04. In such a situation, claim 23 would be rejoined and examined with Group I. However, claim 23 is not only directed to the use of the composition of claim 1, but to the making of the layer of Group II. Thus, this claim links the groups in the manner mandating that the groups be kept together for purposes of examination. It is submitted that this provides further basis to withdraw the Restriction Requirement.

In view of the foregoing discussion, action on the merit of all claims is respectfully requested. Should the Examiner have any questions or comments, he or she is cordially invited to telephone the undersigned at the number below.

Respectfully submitted,



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